

Serial No. 08/428,918

placed within the insect trap compartment, the housing including an upper wall and interconnected side walls extending downwardly to define the compartment aperture, and track means positioned adjacent to an edge of the compartment aperture;

a planar closure member supported by the track means and slidable between a retracted position to permit access to the insect trap compartment through the compartment aperture, and an extended position wherein the closure member covers the compartment aperture, wherein the housing and the closure member, in its extended position, cooperatively provide a fly swatter; and

means for slidably supporting a rear end portion of the closure member relative to the handle, including rear slide camp means on the rear end portion of the closure member through which the handle slidably extends;

wherein the housing further includes a projection extending rearwardly from the insect trap compartment, which projection supports a portion of the track means designed to support a front end portion of the closure member when placed in its retracted position.--

REMARKS

In the above-identified Office Action, the Second Supplemental Declaration of Robert R. Reaver and Carol Reaver was claimed to be defective

Serial No. 08/428,918

under 35 U.S.C. §251. Additionally, claims 1-5, 7, and 9-10 were rejected under 35 U.S.C. §103 in view of the combination of Liebling and Chapman. Claims 6, 8, and 11-13 were objected to as being dependent upon a rejected based claim, and claims 14-19 were indicated as allowable if the rejection under 35 U.S.C. §251 was overcome. In response, Applicant has amended claim 9 to include the recitations of claim 11, and has added new claim 20 which incorporates the recitations of claims 1 and 8. Reconsideration and reexamination of the application, as amended, is respectfully requested.

REJECTION UNDER 35 U.S.C. §251

The Declaration was found to be defective because the error which was relied upon to support the reissue application was not an error upon which a reissue could be based.

The purpose of reissue is to protect a patentee's right to receive the benefits of his invention. *Moist Cold Refrigerator Co. v. Lou Johnson Co.*, 103 USPQ 410 (9th Cir. 1954). Mandamus lies to compel Commissioner of patents to receive application for reissue where Applicant has done all the law requires and all in his power to make application effectual. *Commissioner of Patents v. Whiteley*, 17 U.S. 552 (1867).

In part, 35 U.S.C. §251 states as follows:

Whenever any patent is, through error without
deceptive intention, deemed wholly or partly
inoperative or invalid, by reason of a defective

specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the issue for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent.

Further, according to 37 C.F.R. §1.175(a), a reissue Oath or Declaration is required stating that the Applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis of reissue; and that all errors corrected in the reissue application arose without any deceptive intention on the part of the Applicant.

Patent laws contemplate that reissue patents may enlarge the scope of the claims of original patent, including situations where in the patentee's original application he claimed less than he had a right to claim in the patent. *Hartzell Industries, Inc. v. McCauley Industrial Corp.*, 134 USPQ 275 (6th Cir. 1962). Although the reissue patent may not be granted in absence of error defined in 35 U.S.C. §251, one might err without deceptive intention in adding a particular limitation where a less specific limitation regarding the same feature, or an added limitation relative to another element, would have been sufficient to render the claims patentable over the prior art. *Application of*

Serial No. 08/428,918

Richman, 161 USPQ 359 (Cust. & Pat. App. 1969). Furthermore, 35 U.S.C. §251 imposes no restriction on the manner in which a defect in a patent is discovered. *Application of Richman*, 165 USPQ 509 (Cust. & Pat. App. 1970).

In view of the foregoing, Applicants traverse the rejection under 35 U.S.C. §251 and assert that the Second Supplemental Declaration of Robert R. Reaver and Carol Reaver, filed October 16, 1997, conforms with the requirements of 37 C.F.R. 1.175(a). In paragraph six of that Declaration, the Applicants stated that they believe the original patent to be partly inoperative or invalid because of error without any deceptive intent by reason that Applicants' claimed less than they had a right to claim in the original patent. According to paragraphs 7-14 of the Declaration, Applicants stated with specificity how and when the defects arose. Briefly, the Applicants disclosed in their original application the preferred embodiment and directed claims towards this preferred embodiment, including the recitation of a "mesh closure member". Later, Applicants learned that claiming the invention in such a narrow fashion was in error as the invention could not be economically produced using a mesh closure member. After learning that vacuum thermoform molding techniques allowed the invention to be manufactured economically and that this molding technique prohibited the use of a mesh closure member, Applicants filed the present reissue application within two years of the issue date of the original application to broaden the claims in accordance with 35 U.S.C. §251.

Although no new matter was introduced into the application for reissue, only the claims being amended, the specification and drawings support the amended claims. Although a mesh closure member is described as the preferred embodiment, Applicants have a right to claim simply a "closure member" as such is shown in the drawings and within the scope of the invention. Furthermore, amending "track" to "track means" and "rear slide clamp" to "rear slide clamp means" is also supported by the original patent specification and within the scope of the invention. No evidence is necessary to show that the alternative embodiments were reduced to practice at the time the original application was issued. As stated in *Application of Richman*, there is no restriction on the manner in which a defect in a patent is discovered, and such error can include the addition of a particular limitation where a less specific limitation regarding the same feature, would have been sufficient to render the claims patentable over the prior art. The error committed by the Applicants is exactly the type which the reissue process provides for, namely, claiming less than Applicants had a right to claim without fraud or deceptive intent. Accordingly, the Declaration meets all of the requirements necessary to file a reissue application.

CLAIM REJECTIONS UNDER 35 U.S.C. §103

Chapman (U.S. Patent No. 1,081,364) was used in rejecting several of the claims as being obvious. Chapman discloses a fly destroyer including a bat pivotally connected to an upper portion of a rod so as to be

Serial No. 08/428,918

swingable into a striking position. The bat is constructed of a close mesh screen attached to a frame which, when activated, strikes and kills flies against a wall without crushing them. A receptacle is secured to the rod beneath the bat. The receptacle is in the form of a shallow tray also constructed of the close mesh screen secured to a wire frame.

Referring to claim 1, Chapman does not disclose a rigid housing, but rather a mesh screen housing. If such mesh screen were rigid, the use of such would surely crush the fly against the wall when struck by the bat. Nor does Chapman disclose a track means positioned adjacent to the compartment aperture. Nor does Chapman disclose a closure member slidable between a retracted position to permit access to the compartment and an extended position to cover the compartment aperture. Nor does Chapman disclose a rear slide clamp means through which the handle slidably extends.

Liebling (U.S. Patent No. 4,272,906) was used to overcome the deficiencies of Chapman. However, Liebling discloses a fish net comprised of conventional mesh or net material (column 2, line 39). The container comprised of the net material is not rigid as seen in FIG. 3, and independent claims 1 and 9 where the container is described as flexible. In addition to failing to overcome the shortcomings of Chapman, there would have been no motivation for someone skilled in the art to incorporate the teachings of a fish net to a fly swatter or insect trap. Accordingly, claims 1-8 are not rendered obvious by Chapman and Liebling.

Serial No. 08/428,918



Claims 14-19 were indicated as allowed if the rejection under 35 U.S.C. §251 was overcome. Applicant believes that such rejection has been overcome. New claim 20 incorporates the recitations of claim 1 and objected claim 8, which is in condition for allowance as the rejection under 35 U.S.C. §251 has been overcome.

RECEIVED
AUG 23 2000
103600 MAIL ROOM


CONCLUSION

In view of the foregoing amendments and remarks, Applicants believe that all claims are in condition for allowance, notice of which is hereby respectfully requested.

Respectfully submitted,

KELLY BAUERSFELD LOWRY & KELLEY, LLP

By



Aaron T. Borrowman
Reg. No. 42,348
Attorney for Applicant

ATB:sbn
Enclosure

6320 Canoga Avenue
Suite 1650
Woodland Hills, CA 91367
(818) 347-7900